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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,464	02/07/2001	Jean-Paul Cano	ESSI:005CP1	5911

7590

10/11/2002

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 10/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/778,464

Applicant(s)

CANO ET AL.

Examiner

D. S. Nakarani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☒ Copies of the certified copies of the priority documents have been received in the National Stage application from the International Bureau (PCT Rule 17.2(a)).
- Application No. 08/682,602*
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 14 and 17 are objected to because of the following informalities: Claim 14, line 2, the word "costing" should read -- coating -- and claim 17, line 7, the numeral "35" should be deleted. Appropriate correction is required.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for (1) the abrasion - resistant coating derived from composition of claim 12 and (2) an inorganic antireflective coating having monolayer with optical thickness of  $\lambda/4$  where  $\lambda$  is a wavelength between 450 and 650 nm or having multilayer film comprising three layers with a combination optical thicknesses  $\lambda/4 - \lambda/2 - \lambda/4$  or  $\lambda/4 - \lambda/4 - \lambda/4$ , respectively, or equivalent multilayer with similar optical thicknesses (see page 13, lines 21-29) does not reasonably provide enablement for any abrasion resistant coating and any antireflective coating (e.g. see U.S. Patent 4,904,525). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification as filed does not teach or suggest hard coating such as organic resin coating, inorganic coating etc. All coatings have somewhat abrasion resistant. The claimed invention does not claim minimum abrasion resistant. Also, there is no disclosure of an anti-reflective coating other than inorganic coating.

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4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 12 and 14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 12 and 14 of prior U.S. Patent No. 6,051,310. This is a double patenting rejection.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5, 6, 10, 11, 13, 15, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al (U.S. Patent 4,904,525).

Taniguchi et al disclose an anti-reflection optical article such as an optical lens (col. 1, lines 10-12). Taniguchi et al.'s article comprises a substrate such as polystyrene, polycarbonates, etc. (col. 2, lines 37-44) coated with hard coating (col. 2, lines 55-65), a fluorine containing organopolysiloxane based film and second coat of a fluorine containing organopolysiloxane based film having F/Si ratio less than 80% (col. 7, lines 59 to col. 8, line 43). The thicknesses of hard coat layer and first and second fluorine containing organopolysiloxane based film falls

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within the claimed range (see abstract, col. 3, lines 35-36, 46-51 and col. 8, lines 28-31).

Taniguchi et al also disclose pretreatment such as chemical treatment (col. 8, lines 36-37), ion bombardment, oxygen plasma etc. (col. 6, lines 18-40) of hard coating coated article. Taniguchi et al. also disclose dip coating, spray coating etc. (see col. 9, line 48 to col. 11, line 30).

Taniguchi et al. fail to disclose that hard coating is also abrasion resistant coating. However, in absence of claiming minimum level of required abrasion resistant, any hard coating deemed to have somewhat abrasion resistance. Taniguchi et al.'s second fluorine containing organopolysiloxane based coating deemed to have some anti-reflective properties. Furthermore person of ordinary skill in the art would have found it obvious to adjust abrasion resistance and anti-reflective properties of respective layers for desired application.

8. Receipt of Information Disclosure Statement filed September 18, 2001 is acknowledged and has been made of record.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D.S. Nakarani whose telephone number is (703) 308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J. Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 872-9311 for After Final communications.

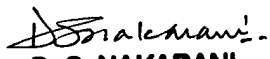
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

D. S. Nakarani/rmn  
October 10, 2002

  
**D. S. NAKARANI**  
**PRIMARY EXAMINER**